

Application No.: 10/820,641

**Remarks/Arguments**

Applicants thank the Examiner for acknowledging the allowability of Claims 11-18. Claim 1 has been amended to include the limitations of claims 3 and 4 and a limitation from Claim 11. Claims 24-27 present additional limitations relating to the track on the upper case, and correspond to limitations presented in original claims 11-18. No new matter is added by the amendment. Each rejection will be reviewed under a separate heading below. Withdrawal of the rejections is respectfully requested.

**Obviousness rejection**

Claims 1-5, 10, 19 and 20 have been rejected under 35 USC 103 as being obvious over Willens (US 2,444,392) in view of CH 666,979. Applicants traverse.

In support of the rejection, the Examiner states that "Willens discloses a watchcase [fig. 5] comprising a lower case [11] characterized by a first annular recess [not explicitly labeled; recess wherein 12 is fitted into 11] for receiving an optically cylinder [12]...." Contrary to the Examiner's statement, the clock of Figure 5 is not a watchcase but is a mantel clock. It is not understood what is meant by an "optically cylinder," but the cylinder [12] is not optically transparent. Indeed, the cylinder that corresponds to [12] is the part of the mantel clock that presents the indicia, specifically, it is the "hour hand" of the clock. In Willens, this part rotates and is not fixed, relative to the lower case. In the claimed invention, the optically transparent cylinder is fixedly connected to the lower case, does not indicate the hour but is optically transparent to allow the internal timepiece mechanism to be viewed. Thus, while the lower case of the mantel clock has an annular recess to receive the "hour hand," the "hour hand" has a different function from the optically transparent cylinder of the claims and is mounted differently.

The Examiner goes on to state that Fig. 5 has "an upper case [13] characterized by on the bottom surface thereof a second annular recess [groove 32] for receiving an optically cylinder...." The groove labeled 32 in Fig. 5 is a "vertical groove" (see Column 2, lines 45-46) along the center axis of the element and is part of the internal configuration of the "minute hand" for the mantel clock [13]. This vertical groove is not

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annular in configuration or present on the bottom surface. Further, it does not receive a cylinder, but receives a sleeve with an external projection that permits the minute hand to rotate around its center axis. Neither the sleeve nor the screw that resides within the sleeve are optically transparent and are neither the "hour hand" referenced to by the Examiner nor the optically transparent cylinder referenced by the claim. In contrast, the claims require a second annular recess on the bottom surface of the upper case. This limitation is simply not shown by the reference.

The Examiner continues stating that the upper case [13] is further characterized on the upper surface thereof, "a track [portion wherein 27 is engaged with 14] for removably receiving and securing an ornamental top. Element 27 of Willens is a shaft or screw internally disposed along the center axis of the mantel clock. The shaft is not a part of segment 13 or even fixed to segment 13. Please recall that segment 13 rotates and is the "minute hand." The shaft is fixed and screws into the top of the clock. Neither the shaft, nor the sleeves in which the shaft resides, are "tracks" on the upper surface of the upper case. The best description of that which exists on the upper surface of segment 13 (what the Examiner refers to as the "upper case" and what is referred to herein as the "minute hand") is a hole. It is not believed that a hole through the upper surface, or an independent and distinct shaft rising above the surface, can be reasonably construed to mean a "track" "on the upper surface." Again, the elements of the claims and the prior art differ in function, in form and in how they relate to each other. To further highlight the structural difference between the claimed invention and prior art mantel clock, the claim has been amended to add an additional characteristic to the track, i.e., that it be configured with a groove to receive a bayonette. This too is not shown by Willens.

The Examiner concludes the discussion of Willens by asserting that the lower case [11], cylinder [12] and upper case [13] are fixedly connected. The "cylinder [12]" (i.e., the "hour hand") and "upper case [13]" (i.e., the "minute hand") of the mantel clock of Willens are mounted to rotate independently of each other. The lower case is fixed. This is not true of the cylinder and upper case of the claimed watchcase. The upper case, lower case and optically transparent cylinder are fixedly connected, i.e., they do not rotate. If one were to add annular recesses to the bottom surface of segment [13] and the

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top of segment [11] to fixedly connect the cylinder [12] of the mantel clock of Willens, as suggested by the Examiner, the mantel clock would simply not work.

CH666,979 is cited to establish that the use of a transparent dome over a base in a timepiece is known. The Examiner concludes that "It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a transparent material... for the purpose of viewable beyond the surface of the cylinder." Even assuming that this were true, one would still not arrive at the claimed invention because the cylinder of the claims is fixed while the cylinders of Willens (irrespective of the material from which it is made) are not. Indeed, the claims are not directed to the mere substitution of a material in or the addition of a dome over the mantel clock of Willens. The claims are directed to the specific combination of elements in a specific way to arrive at a watchcase that possesses the advantages of having an easily removably ornamental top.

Even if one were to view the teachings of CH '979 to broadly teach that adding a glass barrier between the rotating, cylindrical timepiece elements of Willens and the user is obvious, one would not arrive at the claimed invention. Willens differs from the claimed invention in almost every element. Willens is directed to a mantel clock while the invention is directed to a watchcase. These timepieces differ not only in their size, but how they are used. Further, the manner in which these timepieces are constructed, particularly with respect to the optically transparent cylinder and the upper case, differ. The optically transparent cylinder is missing from Willens altogether. The lower case, while having an annular recess to receive a rotating timepiece, does not possess an annular recess to receive such a cylinder. The upper case referred to by the Examiner is also rotating. Not only does it not have an annular groove to receive an optically transparent cylinder beneath it, one would not be motivated to add such a groove in the Willens timepiece because it is, itself, rotating. While Willens teaches an ornamental top, the top is not fixed to a separate upper case along a track on its upper surface. Indeed, it is believed that the Willens clock is actually missing the fixed upper case, as referred to in the invention, altogether.

Referring to Figure 2B of the present application, Willens is missing the cylinder [15], the annular recess [20] in the lower case to receive the cylinder, the upper case [12]

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and/or its annular recess [21] on the lower surface to receive the cylinder and/or the track [22] on its upper surface to receive the ornamental top.

With respect to claim 4, which has now been incorporated into claim 1, the Examiner states that, while Willens discloses a cylinder having time increments thereon, viewing the time increments through the optically transparent cylinder is not taught. The Examiner relies upon CH '979 to teach this element. The time increments in CH '979 are placed on the dome. Thus, one does not view the time increments through the dome. Nonetheless, for the reasons set forth above, the invention is more than the mere addition of a cylindrical glass barrier between a timepiece and its user.

With respect to claim 5, it is true that Willens teaches a screw placed centrally through the pieces. However, the screw does not fixedly connect these pieces. It is believed that this language clearly requires these elements to be fixed, or stationary, with respect to each other. Elements [12] and [13] are characterized by a sleeve that receives the screw. They are not fixed to the screw nor are they fixed to the lower case or to each other. They move, i.e., rotate around the screw, independently.

With respect to claim 10, Willens is said to present a track that is annular and disposed below the plane of the second annular recess of the upper case. The "track" to which the Examiner refers is the central sleeve of element [13], the sleeve is more or less cylindrical in form. The sleeve is, essentially, a simply hole through the middle of the element and is not annular (shaped like a ring). Further, it is not disposed on the top surface of the upper case. Further, sleeve is located completely above the bottom surface of the element and, therefore, does not meet the limitation that the track is disposed below the plane of the second annular recess of the upper case (which is on the bottom surface of the upper case). Finally, the element to which the Examiner refers is not an upper case for the clock, but is the rotating "minute hand."

With respect to claim 19, the Examiner states that it would be obvious to add a wristband to the mantel clocks of the prior art. Again, Applicants disagree. More is required to make a mantel clock suitable for wearing than merely adding a watch band. Thus, the rejection appears to overly simplify the issues facing the inventors. The invention is directed to making a cylindrical wristwatch that can easily remove and replace ornamental tops but still possess a high degree of security for the tops. The

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claims are not directed to a wristwatch where the ornamental top is fixed via a screw, as Willens fixes the upper case of his mantel clock or as Hohenstein et al (US Patent 6,891,778 or its corresponding PCT) fixes the sculpture onto the watch.

The Examiner goes on to reject claims 6-9 over Willens and CH 666,979, as cited above further in view of Harrison (US 2,036,046). Harrison is relied upon to teach a plurality of screws to engage the cases together. Keeping in mind that the referenced pieces of Willens need to rotate independently of each other around a center axis, whereas the referenced elements of the presently claimed invention do not, it is not seen how multiple screws could be incorporated into Willens's clock through the referenced elements in an annular arrangement and retain their ability to rotate, particularly where the screws are disposed within the cylinders (Claim 7). It is noted that elements 18 and 32 of Harrison, referenced by the Examiner are not screws but are wheels.

While the location of the screws may appear to be a trivial element, where, as here, it is important to secure and fix certain elements (the upper case, lower case and optically transparent cylinder) while maintaining the ability of other elements to rotate (the timepiece mechanism) and yet others to be easily added or removed (the ornamental top), screw placement becomes important. Indeed, the references relied upon by the Examiner do not show an arrangement that would be successful.

In summary, the references do not teach the claimed invention individually or in any combination. Withdrawal of the rejection is requested.

#### Anticipation Rejection

Claims 21-23 have been rejected as being anticipated by Fisk. Fisk is stated as teaching an ornamental top [18] adapted to be "worn" on a "watchcase" [10] connected by a flange extending inwardly and at least one bayonette outwardly from said flange to engage in a track. Fisk teaches a mantel clock which is not a watch nor is it worn. Even with the above notwithstanding, the top of the mantel clock does not show at least one bayonette. Figure 2 of Fisk shows a removable flange [18] which allows the top to be removed. This suggests that the element that extends into the track created by flange [18] and cylinder [12] is a contiguous annular element, not a bayonette that is configured to

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removably engage into a track of the watchcase of claim 1. The method of removing the top of this mantel clock simply does not teach or suggest a bayonette.

Applicants again acknowledge with appreciation that the Examiner agrees that the combination of the watch case of Claim 1 and the ornamental top of Claim 21 is not taught by the prior art and is allowable. For all the reasons set forth above, these individual elements are also allowable over the prior art.

**Conclusion**

In view of the above amendments and remarks, it is believed that all claims are in condition for allowance, and it is respectfully requested that the application be passed to issue. If the Examiner feels that a telephone conference would expedite prosecution of this case, the Examiner is invited to call the undersigned at (978) 251-3509.

Respectfully submitted,

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